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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,216	11/10/1999	YOSHIHIRO TERADA	046601-5028	7662

9629 7590 06/15/2004
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

BRINICH, STEPHEN M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/15/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,216

Applicant(s)

TERADA ET AL.

Examiner

Stephen M Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10,12,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 9,11 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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11

DATE MAILED:

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Commissioner for Patents

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5-6, 8, 10, 12, & 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al (5471821).

Re claims 1, 5, 8, 10, 12, & 14-15, Hayashi et al '821 discloses (column 13, lines 41-53; column 18, line 66 - column 19, line 16; column 20, lines 16-26) an image processing arrangement in which a scanning system generates image data from an original document and a discriminating system immediately (at the time of scanning and prior to recording the image) determines whether a predetermined inhibit image is present in the original image. An editing system then alters the image data (which at this point includes the inhibited image data), e.g. replacing the inhibited image region with a specific color, if this inhibit image is found, in order to produce an output image. Alternatively, the editing system leaves image data in which no inhibit image is found unaltered in the produced output image. A printout system stores the output of the editing system as hard copy.

Re claims 2-3, a removal or substitution of certain image elements inherently affects the order in which the elements are

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read out afterwards (by removing the deleted or replaced elements from the sequence).

Re claim 6, the Hayashi et al '821 scanner is a "predetermined image input system", inasmuch as it is known in advance that images to be processed will be supplied to the image processing system by this means.

Claim Rejections - 35 USC § 103

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al '821 in view of Applicant's admitted Prior Art.

Re claim 7, Hayashi et al '821 discloses a local inputting of image data (by scanning an original document) without the use of an "external device". The connection of external devices to send and receive image data in conjunction with confidential-image printout suppression is known in the art as shown for example by Applicant (Figure 13; page 2, lines 7-15). The use of the Hayashi et al '821 image processing system to process image information from an external device in order to allow remote users to print edited documents would be an expedient obvious to one of ordinary skill in the art.

Allowable Subject Matter

4. Claim 4 is allowed.

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5. Claims 9, 11, & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 4, the art of record does not teach or suggest the claimed selective image rotation in accordance with the output of an image selectively edited in response to the detection of an inhibit image.

Re claims 9, 11, & 13, the art of record does not teach or suggest the inversion of a gradation of a color signal in an inhibited image data portion.

Response to Arguments

7. Applicant's arguments, see Paper #11, filed 21 May 2004, with respect to the rejection(s) of claim(s) 1-3, 5-6, 8, 12, & 14-15 under 35 USC §102 and of claim 7 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hayashi et al '821.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

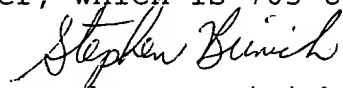
Finkel et al, Hayashi et al (5617187) and Utagawa et al disclose additional examples of copy/printout inhibition in response to a document marking.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.


Stephen M Brinich
Examiner
Art Unit 2624

smb
June 10, 2004